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EXAMINER

DAWSON, GLENN K

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/480,826

Applicant(s)

TAYLOR ET AL.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 13, 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-19, 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States..

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5-12 and 14-19,22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Koros, et al.-5167223.

Koros discloses a rib spreader having a frame 25,30, a 1<sup>st</sup> blade 700, 2<sup>nd</sup> blade 13, foot or shoe 11, actuator 45,55, locking mechanisms 400,500, wherein the actuator moves the 2<sup>nd</sup> blade away from the 1<sup>st</sup> blade along an axis; the locking mechanisms have locked and unlocked positions allowing for pivoting rotation of the 2<sup>nd</sup> blade and foot about an axis transverse to the 1<sup>st</sup> axis. The Foot is movable through adjusting the pivoting of the locking mechanisms 400 and 500 to a position vertically above the frame. See fig. 1,6,13,17,23 and 24. The arm holding the foot or shoe could be pivoted to a position such that it be directed away from all other elements of the device.

Claims 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Giglio, et al.-5520610.

Giglio discloses a retractor having 1<sup>st</sup> and 2<sup>nd</sup> blades 13 attached to a frame 1 and a movable arm 2. The blades can be moved towards and away from each other

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along a 1<sup>st</sup> axis. A foot 38 is movable vertically relative to the frame. A locking mechanism 24,26,27 and 30 locks the foot relative to the frame. See fig. 1,3,8 and 11.

Claims 1,2,10,11,24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tyagi-5755660.

Tyagi discloses a surgical retractor having a frame member 5, blades 13,14 attached to arms which when pivoted such that the blades oppose each other, movement of one of the arms using actuator (or drive member) 23 allows the blade to move relative to the frame along a first axis. A foot (or shoe) 15 attached to an arm coupled to the frame is movable relative to the frame and the blades along an axis transverse to the 1<sup>st</sup> axis. A locking mechanism 20 locks the foot and frame relative to each other. As shown in fig. 2 and 4, the locking mechanisms allow for pivoting of the blades and foot in a direction which is vertical, albeit in an arc. The foot 15 could easily engage an external surface of the chest, either by pivoting it to a point such that the foot was adjacent to the incision, or by removing the foot and placing it outside of movable frame member 8. As shown in fig. 1, the foot is not between the arms holding the retractor blades.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giglio, et al.-'610 in view of Koros, et al.-5167223.

Giglio discloses the invention as claimed with the exception of the actuator for moving the arm and 2<sup>nd</sup> blade towards and away from the other arm of the frame. Koros discloses the use of a crank lever actuator 60 for moving one arm of a frame relative to another. It would have been obvious to have provided an arrangement by which the arms could be moved relative to each other by an actuator, as taught by Koros, as this allows for easier retraction as it would then be unnecessary for the surgeon to place his

hands into the incision and manually push the blades apart. The foot 38 could be withdrawn and pivoted to a position such that it was entirely outside the frame and could then engage an external surface of the chest. It could also be moved to a position that it was not between the two arms inside of the frame.

***Allowable Subject Matter***

Claims 4,13,20 and 21 are allowed.

***Response to Arguments***

Applicant's arguments filed 05-23-2005 have been fully considered but they are not persuasive.

The hook of Koros is clearly capable of engaging, or touching an external surface of the chest. As outlined above, even though this is not disclosed it is possible. As the claims are apparatus claims and cannot position any part of the device relative to the patient's body, the prior art anticipates a limitation with respect to the intended use of the device or a functional recitation if it is deemed to be capable of performing the intended function or use. The examiner contends that such a configuration is possible given the prior art's structural elements.

The fact that element 13 is a retractor does not prevent it from also being or including a "blade". Any of the three distal elements could be the blade, or the three together could be a trifurcated blade. Each of the blades retractors or feet etc. is coupled to the frame through some type of coupling. "Arm" 40, as named by the applicant couples the blade to the frame. It is not necessary for the examiner to limit the

configuration one would use when operating the prior art device in its intended manner. Any possible configuration that the prior art device can be placed in can be used to determine if the prior art meets the claimed functional recitations. It need not be obvious to place the device in the claimed manner, it need only be capable. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

The same arguments with respect to intended use or functional recitations are deemed to be applicable to applicants arguments with regards to Giglio and Tyagi as well.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
July 26 2005